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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,652

10/20/2006

Colin John Ingham

65959/58

2997

1912

7590

07/23/2009

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
90 PARK AVENUE  
NEW YORK, NY 10016

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

07/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,652	<b>Applicant(s)</b> INGHAM, COLIN JOHN	
	<b>Examiner</b> Kailash C. Srivastava	<b>Art Unit</b> 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 and 54 is/are pending in the application.
- 4a) Of the above claim(s) 40-49 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Response filed 01 May 2009 to Office Action mailed 17 April 2009 is acknowledged and entered.

### Claims Status

2. Claims 1-49 and 54 are currently pending.

### Election /Restriction

3. Election without traverse of Group Ia encompassing Claims 1-39 drawn to a device in the response filed 01 May 2009 is acknowledged and entered. Since the election is made without traverse, the restriction requirement is deemed proper and is made FINAL.

Accordingly, Claims 40-49 and 54 are withdrawn from further consideration as being directed to a non-elected invention. See 37 CFR §1.142(b) and MPEP §821.03.

4. Claims 1-39 are examined on merits.
5. Upon further consideration that the device claimed in Group I invention comprises a number of ingredients, the following restriction is required under 35 U.S.C. §121.

### Species Election

6. This application contains claims directed to a device encompassing different ingredients as listed in the species categories below:
  - a. An agent or condition as listed in Claims 6-9, 12;
  - b. Permanent compound: polymeric materials, e.g., latex, rubber, plastic, resin, glue, protein, polypeptide, or carbohydrate listed in Claim 3, non-polymeric materials listed in Claim 4, or lubricant listed in Claim 11;
  - c. Effector molecule, chosen from the group consisting of: agonists, antagonists, antibiotics, antibodies, antibody fragments, carbohydrates, chaperone proteins, differentiation-inducing agents, drugs, drugs selected from a chemical or natural drug candidate library, enzymes, glycolipids, growth factors, hormones, inducer molecules, inhibitors of cellular functions, mutagens, nucleic acids, nutrients, oligopeptides, proteins, secondary

metabolites, substrates, test compounds, toxins, transcription factors, or analogues of any of said compounds as listed in Claims 16-18, 21-24, 27 and 34 respectively;

- d. Mode of movement of effector molecules through the porous support among: passive support, active support, or diffusion and if active: pumping, magnetically, electrically, or piezoelectric; and
- e. Living organism chosen from the group: *Amoeba*, bacteria capable of moving over solid surfaces, colonial gliding bacteria, *Dictyostellum discoideum*, *Drosophila melanogaster*, motile spores and gametes, *Myxobacter xanthus*, nematodes, other insects assuming that their normally present ability to jump or fly is disabled, protozoa, slime molds, migrating tissue culture cells from larger organisms and wingless mutants of *Drosophila*.

Applicants are required under 35 U.S.C. §121 to elect as follows only one species member for further prosecution from **each** of the species categories a-e listed *supra*.

The non-taxonomic species listed *supra* are independent or distinct because claims to the different non-taxonomic species listed *supra* recite the mutually exclusive characteristics of such non-taxonomic species. In addition, these non-taxonomic species are not obvious variants of each other based on the current record.

7. Applicants are required under 35 U.S.C. §121 to elect only a single disclosed species for further prosecution on merits to which Claims shall be restricted if no generic claim is finally held to be allowable.

There is an examination and search burden for the above-mentioned patentably distinct non-taxonomic species due to their mutually exclusive characteristics. The non-taxonomic species require a special field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely raise different non-prior art issues under 35 U.S.C. §101 and or 35 U.S.C. §112, first paragraph.

8. **Applicants are advised that the reply to this requirement to be complete must include (I) an election of a species to be examined** among the species listed in categories a-j or as listed in A-J even though the requirement may be traversed (37 C.F.R. §1.143) **and (II) identification of the claims**

**encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable, or that all claims are generic is considered non-responsive unless accompanied by an election.

9. The election of species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 C.F.R. §1.144. If claims are added after the election, applicants must indicate which of these claims are readable on the elected species.

Should applicants traverse on the ground that the species are not patentably distinct, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other species. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141.

10. In accordance with 37 C.F.R. §1.499, applicants are required that a reply to this requirement must include an identification of the non-taxonomic species that are listed in I-II *supra*, and is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election of a Group and a corresponding species. If claims are added after the election, applicant must indicate which Claims are readable upon the elected species [M.P.E.P. §809.02(a)].

11. Applicants are reminded that upon the cancellation of claims to a non-elected invention and species, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(I).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kailash C Srivastava/  
Examiner, Art Unit 1657

Kailash C. Srivastava  
Patent Examiner  
Art Unit 1657  
(571) 272-0923

13 July 2009

/JON P WEBER/  
Supervisory Patent Examiner, Art Unit 1657